

## **REMARKS**

### **Information Disclosure Statement**

Applicants have provided a digital copy of the patents and publications cited in the Information Disclosure Statement filed on November 19, 2002. Therefore, consideration of the patents and publications submitted in the Information Disclosure Statement filed on November 19, 2002 is respectfully requested. No additional fee is necessary for consideration of this Information Disclosure Statement since paper copies of these references were provided with the Information Disclosure Statement on November 19, 2002 and the submission was complete.

Applicants also submit the copending applications identified in the Information Disclosure Statement should be considered. These copending applications are assigned to the same Assignee as the present invention and are also directed to aryl ureas. Although these applications were identified without publication dates, the filing date and serial number for each of these applications were given, which is sufficient to identify the application within the USPTO. Applicants submit each of these applications should be considered although some may be unpublished or were published after the priority date for this application. Copies of the pending claims in these applications have been provided as requested by the Examiner.

As the Examiner noted in the Notice of Allowance dated July 30, 2002, WO 00/42012 and the above-identified application name the same inventive entity. Thus, the PCT publication is not prior art under 35 U.S.C. §102(a). Claims to some subject matter for which each named inventor made an inventive contribution were intentionally included to maintain the same inventive entity for this application as that of the cited PCT publication. However, even if the subject matter of this application had been limited to a particular salt having only a subset of inventors from the PCT publication, there still would be no prior art effect under 35 U.S.C. §102(a). This is because, to the extent the PCT document discloses such narrower subject matter having a smaller inventive entity, this constitutes a disclosure, not more than one year before the effective filing of this application, of the invention of the same smaller inventive entity of this

application. This would not constitute a prior art event. *In re Katz*, 687 F. 2d 450, 215 USPQ 14 (CCPA 1982).

Under the same rationale, the PCT publication and any subsequent U.S. patents issuing therefrom, cannot be references under 35 U.S.C. §102(e) against this application. All of them will either have the same inventive entity as this application or, under the hypothetical situation discussed above, i.e., in a different inventive entity situation, 35 U.S.C. 102(e) also can not apply under the *Katz* rationale. *In re Costello*, 717 F. 2d 1346, 219 USPQ 389 (Fed. Cir. 1983). Moreover, 35 U.S.C. §§102(e) /103 would also not apply because, at all times, all subject matter of the PCT document and that of this application were commonly owned. (35 U.S.C. 103(c)).

This application, copending application Serial No. 09/993,647 filed on November 27, 2001, copending application Serial No. 09/907,970 filed on July 19, 2001 and copending application Serial no. 10/042,226, filed January 11, 2002, were all filed without claiming benefit of the earliest possible priority to which they could have been entitled, i.e., that claimed in the cited PCT document. These applications are drawn to commercially important subject matter whose patentability is especially clear and especially clearly does not need the benefit of such priority. In light of forgoing priority, the current and the other application(s) will, upon issuance, produce patents thus having 20 year terms starting and ending later than they would have if priority were not forsaken.

Furthermore, the reason for the preliminary amendment of January 12, 2001 was to limit this application to such especially clearly patentable subject matter.

#### 35 U.S.C. § 103

The genus defined in the Adams et al. reference, U.S. Patent 5,447,957, does not encompass the subject matter claimed herein. The reference requires the atom which bridges the two phenyl groups (X) be positioned ortho to the group “-NR<sub>4</sub>R<sub>3</sub>.” In the genus defined by Adams et al. only “-

NR<sub>4</sub> R<sub>3</sub>" can form a urea moiety. Therefore, the compounds of Adams et al. require the X-bridged phenyl group be positioned ortho to the urea moiety.

The compounds claimed herein do not have the O-bridging atom positioned ortho to the urea moiety. This distinction in structure alone is sufficient to render the compounds claimed herein unobvious in view of Adams et al.

Certain compounds claimed herein have additional features which take them further outside of the broad genus of Adams et al. For example, the broad generic formula of Adams et al. does not encompass compounds with pyridinyl groups as positioned in the claimed compounds.

No evidence has been presented to show or suggest one skilled in the art would be motivated to modify the teachings by Adams et al. to obtain compounds outside of the scope of the Formula I therein. Therefore, the subject matter claimed herein is unobvious over this reference.

#### Double Patenting Rejection

The subject matter claimed in copending applications 08/863,022, 09/755,060 and 09/947,761 is directed to thiophene, furan and pyrrole ureas and methods for their use. The compounds claimed herein do not contain a thiophene, furan and pyrrole heterocycle. This structural distinction alone renders the compounds claimed herein unobvious in view of the claimed subject matter within these applications.

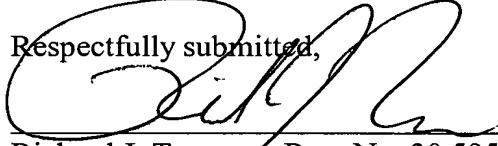
The claims in copending application 09/776,936 define bridged aryl ureas where in formula I, one of R<sup>3</sup>, R<sup>4</sup>, R<sup>5</sup> or R<sup>6</sup> is -M-L'. L' is defined as an aryl or heteroaryl moiety, optionally substituted, and M is defined as a bridging group. The compounds claimed in application 09/776,936 are distinct from the compounds claimed herein in that the aryl/heteroaryl moiety, L', has distinct substituents. The substituents for L' in Serial No. 09/776,936 are alkyl, alkoxy, halogen, hydroxy, nitro and thiomethyl groups whereas the substituents for L' which appear on the compounds claimed herein are

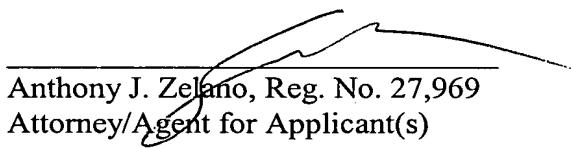
carbamoyl or n-methyl carbamoyl. No evidence has been presented of motivation for one skilled in the art to replace the alkyl, alkoxy, halogen, hydroxy, thiomethyl and/or nitro substituents of Serial No. 09/776,936 in order to arrive at the carbamoyl or N-methyl carbamoyl containing compounds of this invention.

With respect to claims 17, 18, 22-25 of copending application S.N. 10/071,248, the double patenting rejection made in S.N. 10/071,248 based on the claims herein was withdrawn in the Office Action dated April 24, 2003.

As to applications 09/773,604, 09/773,675 and 09/773,659, 09/773,658 and 09/773,672, they have been expressly abandoned, as shown by the papers attached hereto.

Based on the above remarks, Applicants submit that the rejections should be withdrawn and the Information Disclosure Statement filed on November 19, 2002 should be considered.

Respectfully submitted,  
  
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